

Remarks/Arguments

Summary of the Office Action

Claims 1-17 are currently pending.

The Examiner rejected Claims 1-17 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Publication No. 2003/0005449 to McKenna et al. ("McKenna") in view of U.S. Patent No. 6,088,722 to Herz et al. ("Herz").

Introduction

Applicant respectfully traverses the prior art rejections of the claims 1-17.

Rejections under 35 U.S.C. § 103(a)

Applicant respectfully submits that the Examiner has incorrectly rejected claims 1-17 without properly establishing a *prima facie* case of obviousness under 35 U.S.C. 103(a). To establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. (*In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

Manual of Patent Examining Procedure, § 2143.

Even assuming *arguendo* that McKenna may be properly combined with Herz, et al., McKenna fails to disclose or suggest the features of claim 1, either alone or in combination with Herz, et al. Thus, the Examiner has not meet his burden of establishing a *prima facie* case of obviousness.

Neither McKenna nor Herz disclose all elements of claim 1

Independent claim 1 of the present invention recites a method for conducting a survey and storing the response to the survey in a provider's database for further processing.

Regarding claim 1, the Examiner lists the portions of claim 1 with corresponding references from McKenna that allegedly create the basis for 35 U.S.C. 103(a) rejection of claim 1. For example, the Examiner writes, *inter alia*: “and storing (CH-DEC-Vendor 12 or Uplink Server/DMZ-34/40 of Uplink 14) the response to the first survey and the response to the second survey of in a particular database (Server 22 of CH-DEC_Vendor 12 or Uplink Server/DMZ-34/40 of Uplink 14, page 2, 0020-0023], note that CH-DEC-Vendor or Uplink-14 continuously checks the list to determine if any changes have been made to the list and response to the change of each specific Hotel/Site 18-1 to N and their Guest and attaches sites file to each DEC file in response to the interactive services to the various Guest within each Hotel/Site (page 2, [0022-0023]; page 3, [0028-0030] and [0032-0033]).” (Office Action, p.5).

However, Applicant notes that McKenna discloses that digital content receiver “stores the encrypted DEC after it has been received on satellite dish 40”, and further that digital content receiver “contains a removable hard drive, preferably having a storage capacity of at least 75 gigabytes (GB)” (McKenna, page 2, [0023]), where “DEC” stands for digital entertainment content and is simply encrypted movie or a video game. Applicant also notes that McKenna discloses:

“As the DEC is encrypted, a "sites file" is attached to each DEC file (i.e., movie, video game, etc.). The sites file contains the name of the DEC file, a flag to indicate whether the DEC file is to be delivered to all sites, and, at times, an individual flag for every site that is to receive the DEC file. For example, if the flag indicating whether the DEC file is to be delivered to all sites is activated, then all sites having a satellite downlink would receive the DEC file, and no individual sites would be listed. Alternatively, if the flag indicating whether the DEC file is to be delivered to all sites is deactivated, then a list of individual sites to receive

the DEC file (with flags activated) would also be included in the sites file.” (McKenna, page 2, [0020]).

However, McKenna does not disclose or suggest that DEC file or “sites file” contain users generated data consecutively stored in a database. Similarly, Herz does not disclose or suggest that DEC file or “sites file” contain users generated data consecutively stored in a database. Accordingly, McKenna and Herz, even when viewed in combination, do not render claim 1 obvious.

In addition, claims 2-9 depend from claim 1, therefore claims 2-9 are patentable for the same reason as claim 1.

Furthermore, dependent claim 6 further recites the feature of “transmitting a particular message to a representative of the first entity when at least one portion of the electronic response to the first survey corresponds to a particular predetermined response.” As a result of this action, the representative may offer the hotel guest a complimentary meal from the room service menu.

The Examiner asserts that “McKenna further discloses transmitting a particular message to a representative of the first entity or the second entity (Hotel/Site 18-1 to N) when at least one portion of the electronic response to the first survey corresponds to a particular predetermined response (page 3 [0031]).” (Office Action, p. 6). Applicant notes however, in paragraph [0031] McKenna describes the feature of the system that provides the ability to deliver DEC file automatically as soon as the new DEC file (e.g., new movie) becomes available. McKenna further describes the alert system for alerting guests as soon as the new movie becomes available. McKenna does not disclose or suggest the additional feature of claim 6. Accordingly, for this additional reason, McKenna does not render claim 6 or its further dependent claim 7 obvious.

For at least the above reason, Applicant respectfully submits that the rejection of claims 1-9 under 35 U.S.C. §103(a) based on McKenna in view of Herz should be withdrawn.

Applicant respectfully submits that claim 10 has similar limitations as claim 1, therefore claim 10 and its dependent claims 11-16 are patentable for the same reasons as claim 1.

Applicant also submits that claim 17 has similar limitations as claim 1, therefore claim 17 is patentable for the same reasons as claim 1.

CONCLUSION

Based on the foregoing, Applicant submits that the present application is now in condition for allowance. The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication to Deposit Account No. 02-4377. In the event that the application is not deemed in condition for allowance, the examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,


Paul A. Ragusa
PTO Reg. No. 38,587
(212) 408-2588

Attorney for Applicant
BAKER BOTTS L.L.P.
30 Rockefeller Plaza
New York, NY 10112